

REMARKS/ARGUMENTS

Applicant has carefully reviewed the Office Action dated December 14, 2004 and thanks the Examiner for the detailed review of the pending claims. Claims 1-11 have been cancelled without prejudice or disclaimer as having been drawn to a non-elected invention. Claims 12-18 stand rejected and will be pending upon entry of this paper. New claims 19-26 have been added; however, no new matter has been added. Applicant requests reconsideration of the pending claims in view of the following remarks.

Claim Rejections – 35 U.S.C. §103(a)

A. Claims 12-14 and 16-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tomesko (U.S. Patent No. 4,502,909) in view of Yealy (U.S. Patent No. 4,140,569). For at least the following reasons, Applicant respectfully traverses the rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (Emphasis added). See MPEP 2143.

In the present case, to establish a *prima facie* case of obviousness, Tomesko and Yealy must teach or suggest each of the claim limitations recited in claims 12-14 and 16-18. The Office Action admits that Tomesko differs from the claimed invention in that it "lacks structure analogous to the second extendible member and method associated with the extendible member." The Office Action further states that:

"Yearly discloses the use of three extendible members (138, 168 and 124-see figure 4) for manipulation and compressing bonding. Such additional members [allow] additional manipulation of the substrates, and would enable more accurate positioning. Therefore it would have been obvious to ordinary skill in the art at the time the

invention to have utilized three independently extendable members in order to achieve better positioning and control over the members.”

Contrary to the Office Action, Yealy does not disclose a method of assembling first and second members that includes the steps of extending a first independently extendible member to orient a dispenser about a first member or extending a second independently extendible member to join the first and second members. While Yealy arguably teaches a mechanism that includes an independently extendable member 138 that aligns a spout 52 and a tube 48, Yealy fails to disclose an independently extendable member that orients a dispenser about the spout 52 or an independently extendable member 124 that joins the spout 52 to a tube 48.

Even assuming *arguendo* that Yealy and Tomesko taught or suggested each of the limitations recited in claim 12, there is no motivation to combine the references. Indeed, adding another extendible member to the Tomesko machine would be superfluous since the upper pitch block 36 is already aligned with the lens precursor 34 and all that is required after dispensing the glue is to move the upper pitch block 36 into contact with lens precursor 34.

The claims that depend from claim 12 are also patentably distinct from Tomesko and Yealy. For example, Tomesko and Yealy fail to disclose a method wherein the compression applied to the first and second members is minimized before retracting (after extending) the first and second independently extendible members, as recited in claim 18. The Office Action has not directed Applicant to any portion of the cited references that teach this limitation and the Examiner has not taken office notice.

For at least the above reasons, a *prima facie* case of obviousness has not been established and the claim rejections with respect to claims 12-14 and 16-18 should be withdrawn.

B. Claim 15 was rejected under 35 U.S.C. §103(a) as being unpatentable over Tomesko and Yealy as applied to claim 12 above, and further in view of Young (U.S. Patent No. 4,268,342). For at least the reasons noted above with respect to claim 12, the rejection of claim 15 is not supported by Tomesko and Yealy. Furthermore, Young fails to make up for the

deficiencies of Tomesko and Yealy in that Young fails to disclose a method of assembling first and second members that includes the steps of extending a first independently extendible member to orient a dispenser about a first member, extending a second independently extendible member to join the first and second members, or retracting a third independently extendible member to align the first and second members.

For at least the above reasons, a *prima facie* case of obviousness has not been established and the claim rejection with respect to claim 15 should be withdrawn.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due beyond the fees identified in the accompanying transmittal. However, if an additional fee is due, please charge our Deposit Account No. 50-3145, under Order No. 209518-82935 from which the undersigned is authorized to draw.

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Respectfully submitted,

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